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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,193	11/05/2001	Minoru Yaguchi	08846-084001	8706

7590 05/23/2003

Fish & Richardson  
45 Rockefeller Plaza Suite 2800  
New York, NY 10111

[REDACTED] EXAMINER

SZEKELY, PETER A

ART UNIT	PAPER NUMBER
1714	//

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/889,193

Applicant(s)

YAGUCHI ET AL.

Examiner

Peter Szekely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 22 April 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 3-9 and 11-17 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 3-9 and 11-17 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) Notice of References Cited (PTO-892)      4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.      6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Specification***

1. The disclosure is objected to because of the following informalities: "M" is defined on page 2, lines 20-22 and page 3, lines 5-7 as a monovalent or divalent metal, ammonium or organic amine. In order for monomers (B) or (C) to be an acid "M" has to be hydrogen. As the formulae are defined there is no carboxylic acid monomer present, therefore there cannot be a copolymer made out of them, which contains a mono- or dicarboxylic acid monomer. Whether one of ordinary skill in the art can convert an acid into a salt is beside the point. Can one of ordinary skill in the art make an acid containing copolymer out of the monomers described, which do not contain a -COOH group?

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 3-9 and 11-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Since "M" has to be a monovalent metal, a divalent metal, ammonium or organic amine, the resulting copolymer cannot be a polycarboxylic acid copolymer. The

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copolymer has to contain a carboxyl group in order to be a carboxylic acid copolymer, which means that the "M"-s have to be hydrogen atoms, which the description in claim 3 excludes.

4. Claims 4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The mode of measurement of the average molecular weight does not define said average molecular weight as weight average, number average, viscosity average, peak average or Z average molecular weight. All average molecular weights can be measured by gel permeation chromatography. See "Polymer Science Dictionary", Second Edition, Mark Alger, Chapman & Hall, pp.32-33 (enclosed). The question is, which average molecular weight was calculated from the data yielded by the gel permeation chromatography?

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The polycarboxylic acid type copolymer of claims 4, 6 and 7 and the polyalkylene glycol derivative of claims 5-7 have no antecedent basis in claim 3. Furthermore, both "type" and "derivative" are indefinite. See Paper #8, paragraph 8.

***Claim Rejections - 35 USC § 102***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 3-9 and 11-17 are rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamashita et al.

6,294,015, Yamato et al. 6,239,241, Tanaka et al. 6,187,841, Hirata et al. 6,147,980, Hirata et al. 6,166,112, Kono et al. 6,165,262, Yamashita et al. 6,087,418, Hirata et al. 5,925,184, Yamato et al. 5,707,445, Nippon Shokubai Co., LTD. EP 0 792 850 or Denki Kakagu Kogyo KK 1996JP-0336720.

9. Combining three rejected claims into one does not make the resulting claim allowable. Applicants' failed to show why the cited references allegedly do not apply to the instant invention. Said references prove that applicants' copolymer is known and that it has been used previously in cementitious formulations. Citing case law without showing how it applies is not effective either. The examiner can cite case law also. A reference that clearly names the claimed species anticipates the claim, no matter how many other species are names. M.P.E.P. 2131.02, Ex parte A, 17 USPQ2d 1716 (BPA&I 1990). Picking and choosing may be entirely proper in the context of an obviousness rejection. In re Arkley, 455 F.2d 586,587, 172 UAPQ 524,526 (CCPA 1972). The rejections are maintained.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (703) 308-2460. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Peter Szekely  
Primary Examiner  
Art Unit 1714

P.S.

May 21, 2003